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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,752	03/24/2000	Rudolf Hinterwaldner	3214	2843

7590

03/15/2004

Thomas G Scavone
Niro Scavone Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602

EXAMINER

JOHNSON, JERRY D

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,752

Applicant(s)

HINTERWALDNER ET AL.

Examiner

Jerry D. Johnson

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1764

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 37-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs.

Jacobs, U.S. Patent 5,180,509, teaches metal-free lubricant compositions comprising graphite for use in threaded connections (column 1, lines 9-11). The composition of the invention also comprises a polymeric material which is chosen from polyalkylene polymers, preferably branched polyalkylenes. Suitable polymers include polyethylene, polypropylene and polybutylene (column 3, lines 34-40). Addition of a friction adjusting component chosen from, *inter alia*, a "substance which releases gases at elevated temperatures" (i.e., calcium carbonate, magnesium carbonate and zinc carbonate) is taught in column 3, line 65 to column 4, line 2. The base material preferably comprises an oil or a grease which comprises an oil together with a soap or a polyurethane (column 5, lines 1-5). While Jacobs differ from the instant claims in not requiring the addition of a carbonate additive or polyurethane, it would have been obvious to one having ordinary skill at the time the invention was made to follow the above teachings and arrive at the instantly claimed composition.

Claims 26, 29-34 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide et al.

Koide et al., U.S. Patent 4,104,073, teach a composition comprising a) liquid or semi-solid organic material and blowing agents, b) a phosphoric acid compound, c) polyhydric

Art Unit: 1764

alcohols and/or carbohydrates, d) blowing agents, e) grease, f) heat resistance fiber, g) microballons and other additives (abstract). Component a) may contain, *inter alia*, oligomers of urethane and ethylene-vinyl acetate copolymer (column 2, line 40 to column 3, line 20). The blowing agent emits gas or gases, such as nitrogen, carbon monoxide, carbon dioxide, and ammonia, when thermally decomposed. Examples of useful blowing agents include, *inter alia*, azodicarbonamide (column 4, lines 39-56). Heat resistance fibers, component f), include Teflon® (column 5, lines 50-60). While Koide et al. differ from the instant claims in not requiring the each of the claimed compounds, it would have been obvious to one having ordinary skill at the time the invention was made to follow the above teachings and arrive at the instantly claimed composition.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26-30, 33-38 and 40-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26-30, 33-38 and 41 are confusing, i.e., the independent claims, claims 26 and 34 recite the Markush group language "selection from the group consisting of" and "selected from the group consisting of," respectively, however these claims go on to recite "polyurethanes" three different times within two different groups within the Markush group. These claims also improperly recite the alternative language "or hydraulically setting inorganic substances." Further, claim 26 also contains the misspelled term "poliymides."

Art Unit: 1764

Claims 27 and 35 lack antecedent basis for component b) to be selected from the recited compounds.

Claim 40 lacks antecedent basis for component a) to be "a physically setting polymer selected from polyolefins containing, in copolymerized form, units having functional groups". In claim 40, it is also unclear if the claimed polyolefins are intended to contain, "in copolymerized form," polyamide groups, saturated polyester groups, or poly(meth)acrylate groups.

Applicant's arguments filed April 17, 2003 have been fully considered but they are not persuasive.

Applicants argue

[a] limitation over U. S. 5,180,509 is achieved by the express "anti-seize composition" vs. lubricant composition. A lubricant composition is not an anti-seize composition. (Remarks, page 9).

Applicants' argument lacks merit.

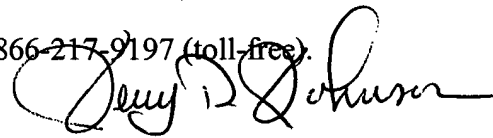
Applicants' claims are directed to a composition, not a particular use of that composition. In any event, the term "anti-seize composition" is not mutually exclusive from lubricant compositions. See, for example, U.S. Patent 5,180,509 entitled "Metal-Free Lubricant Composition Containing Graphite For Use In Threaded Connections" which discloses an "anti-seize composition." See column 1, lines 34-44 of Jacobs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

Art Unit: 1764

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj

Art Unit: 1764

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Art Unit: 1764

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Art Unit: 1764

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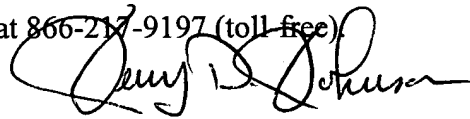
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Art Unit: 1764

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Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj